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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,850	10/29/2003	Eric Woods	12961-014002	8070

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT PAPER NUMBER

3712

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,850

Applicant(s)

WOODS, ERIC

Examiner

Jamila O Williams

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on application filed 10-29-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 9-15 is/are rejected.
- 7) ☒ Claim(s) 6 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-29-03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5,7,11-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the specification what structure is included or excluded from the phrase "glitter particles". It is unclear what the Applicant considers to be a glitter particle (i.e. metals, plastics, etc). Additionally, it is unclear from the specification what is encompassed by the phrase "comprise various shapes and glitter particles". From the specification (page 4 first paragraph), it appears that the glitter particles have various shapes. However, the above- mentioned phrase seems to suggest two different structures "various shapes" and "glitter particles".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5,7,11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the above-mentioned claims, it is unclear what is encompassed by the phrase "glitter particles". Additionally, it is unclear what is

encompassed by the phrase "comprise various shapes and glitter particles", as recited in claims 5 and 7, see rejection above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over '281 to Smith in view of '121 to Goldfarb. Smith discloses all of the methods of the claims including providing a skin (24), filling at least a portion of the skin with substantially hard particles and sealing the skin (column 3 lines 7-13 of Smith), filling a portion of the skin with soft material (column 2 lines 63-68 of Smith). Regarding the limitations of claim 3, where the soft material is placed in the skin prior to the hard particles, it would have been further obvious to fill the skin with soft material prior to the hard particles for the purpose of making it easier to finish the toy. It would have also been obvious as a matter of design to fill the skin with soft material prior to the hard particles since the applicant gives no criticality to the inserting of one before the other (see applicant's specification page 2 lines 23-25)
7. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over '281 to Smith in view of '121 to Goldfarb or in view of '245 to Murza. Due to the fact that the

Examiner is unclear as to the scope of the claims with regards to the phrase "glitter particles", as stated above, the Examiner takes two approaches to the claimed subject matter.

Smith discloses all of the elements of the claims including a primary body and head stuffed with substantially soft material (26) and at least four appendages filled with a bean mix comprising substantially hard particles (32). Smith does not however disclose that the bean mix comprises glitter particles, nor the shape associated with these particles. Goldfarb teaches a bean mix comprising glitter particles (glass beads, in that Webster defines glitter as a sparkling brilliance of something that glitters, to shine by reflection with many small flashes of brilliant light; glass reflects light thus acting as glitter). On the other hand, if glass beads do not satisfy the requirement for "glitter particles", Murza teaches the use of glitter particles as a stuffing material for a stuffed animal toy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the glitter particles of Goldfarb or Murza with the bean mix of Smith for the purpose of providing a varied weight and feel to the user.

Regarding claim 15, it would also have been an obvious matter of design choice to make the glitter particles of whatever form or shape (i.e. heart, star or dot shapes) was desired or expedient. A change in form or shape is generally recognized as being within level of ordinary skill in the art, absent any shown of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

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Conclusion

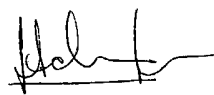
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 703-305-3312. The examiner can normally be reached on 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JW


Jacob K. Aslan
Primary Examiner